

REMARKS

The present application was filed on May 15, 2001 with claims 1-22. Claims 1, 7, 9, 12, 16, 18 and 20-22 are the independent claims. In the outstanding Office Action, the Examiner: (i) objected to the title; (ii) objected to claims 1-19 for various alleged informalities; (iii) rejected claims 1-6 and 9-22 under 35 U.S.C. §101 as being directed to non-statutory subject matter; (iv) rejected claims 1-9, 11, 18, 19, 21 and 22 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,102,406 to Miles et al. (hereinafter "Miles"); and (v) rejected claims 10, 12-17 and 20 under 35 U.S.C. §103(a) as being unpatentable over Miles in view of U.S. Patent No. 6,523,027 to Underwood (hereinafter "Underwood").

Regarding the objection to the title, Applicants have amended the title as indicated above. Accordingly, withdrawal of the objection is respectfully requested.

Regarding the objection to claims 1-19 for various alleged informalities, Applicants have amended certain of the claims as indicated above. Accordingly, withdrawal of the objection is respectfully requested.

Regarding the rejection of claims 1-6 and 9-22 under 35 U.S.C. §101, Applicants have amended claims 1, 7, 9, 12, 16 and 18 to more clearly recite statutory subject matter. Independent claim 20 recites an object embedded in a web page stored at a web site on a network, and Applicants assert that in claim 20 a clear structure is provided that is tied to a technological art. Independent claim 21 recites a storage medium on which input means of computer stores a program in an input-enabled form. Applicants assert that a program permitting the computer to perform certain functions as provided in claim 21, clearly recites statutory subject matter. Independent claim 22 recites a program transmission apparatus comprising storage means for storing a program that permits a computer to perform certain functions. Applicants assert that in claim 22 a clear structure is provided that is tied to a technological art. Accordingly, withdrawal of the rejection of claims 1-6 and 9-22 under 35 U.S.C. §101 is therefore respectfully requested.

Regarding the rejection of claims 1-9, 11, 18, 19, 21 and 22 under 35 U.S.C. §102(e) as being anticipated by Miles, Applicants assert that Miles fails to teach or suggest all of the limitations in independent claims 1, 7, 9, 18, 21 and 22 for at least the reasons presented below.

It is well-established law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicants assert that the rejection based on Miles does not meet this basic legal requirement. Support for this assertion follows.

The present invention, for example, as recited in independent claim 1 recites a computer-based user guidance method. An object that is defined to be obtained by a user, is permitted to appear at a specific location of a specific site. The object is moved and a user who desires to obtain the object is guided to predetermined content available at the specific site. Independent claim 7 recites similar limitations.

Miles discloses an Internet-based advertising scheme employing a scavenger hunt metaphor. During the scavenger hunt the user may click on a hyperlink of a web page to return to the scavenger hunt game site in order to answer a specific question regarding the content of the web page. If the user meets specific requirements and answers the question correctly, the user may obtain a new clue directed to another web page having a hyperlink.

Miles fails to disclose the moving of the object as recited in independent claims 1 and 7. In providing support for the rejection the Examiner directs Applicants to a portion of Miles describing the repeating of the process of finding information on a web page and returning to the game site through a hyperlink. However, Miles contains no description or suggestion that the hyperlink moves. Further, the Examiner contends that having a link appear at a different page, after a previous page is accessed, is inherently moving. However, Miles describes situations in which many users play the scavenger hunt game at the same time. The hyperlinks must remain on the individual web pages for each of the players to find. Therefore, contrary to the Examiner contention, this would require multiple fixed hyperlinks, without the movements recited in claims 1 and 7 of the present invention.

Further, Miles does not contain the disclosure which is necessary to support a claim rejection on the basis of inherency. According to the Court of Customs and Patent Appeals (CCPA), "Inherency does not mean that a thing might be done, or that it might happen, ...; but it must be disclosed, if inherency is claimed, that the thing will necessarily happen." *In re Draeger et al.*, 150

F.2d 572, 574 (CCPA 1945) (emphasis supplied). Furthermore, the well settled law “requires that inherency may not be established by possibilities and probabilities. The evidence must show that the inherency is necessary and inevitable.” *Interchemical Corp. v. Watson*, 145 F.Supp. 179, 182, 111 USPQ 78, 79 (D. D.C. 1956) (emphasis supplied), *aff’d*, 251 F.2d 390, 116 USPQ 119 (D.C. Cir. 1958).

Additionally, “in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). There is no reasonable basis for an assertion that moving an object that appears at a specific location of a specific site, necessarily flows from a having a hyperlink appear at a different page after a previous page is accessed as disclosed in the Miles reference, and thus is inherent. No such basis and/or technical reasoning has been provided by the Examiner in the Office Action.

Miles also fails to disclose an object that is desired to be obtained by a user. Miles describes that players are directed to web pages to obtain desired information that is on the web pages. The object, or hyperlink, only returns the player to the scavenger hunt game site. This differs from independent claim 1, which recites that a user who desires to obtain the object is guided to predetermined content available at a specific site.

Independent claim 9 recites a computer-based user guidance system comprising an object manager for managing the location of an object on a network. The user guidance system also comprises a position information generator for generating information concerning the location of the object, and for providing the information to a user who is accessing the network. Finally, the user guidance system comprises a processor for performing a predetermined process associated with the object selection, when the object is selected by a predetermined user. The object manager arranges the object at a desired location in order to guide the user to desired contents on the network. Miles fails to disclose that the object manager arranges the object at a desired location to guide the user to the desired contents on the network, as described above with regard to claim 1. The object, or hyperlink, in Miles does not guide the user to the desired content on the network.

Independent claim 18 recites a computer-based object control system comprising an object stored in a predetermined server. The object control system also comprises a link setting means for setting a link in a web page stored at a web site on the network in order to move to the object. Finally, the object control system comprises an object position management means for determining a web page for setting a link thereto. Under the control of the object position management means the link setting means changes a target web page for setting a link thereto. Miles fails to disclose a link setting means for setting a link in a web page to move the object. The portion of Miles referred to by the Examiner describes the clicking of a hyperlink to return to a scavenger hunt game site, but does not describe movement of the hyperlink, as described above with regard to claim 1.

Independent claim 21 recites a storage medium on which input means of a computer stores a program in an input-enabled form. The program permits the computer to perform a process for permitting a specific object to appear on a specific web page stored in a specific web server. The program also permits the computer to perform a process for moving the object to another web page when a user browses the specific web page and selects the specific object. Independent claim 22 recites similar limitations to those of claim 21. Miles fails to disclose a process for moving the object to another web page when a user browses the specific web page, as described above with regard to claim 1.

Dependent claims 2-6, 8, 11 and 19 are patentable at least by virtue of their dependency from independent claims 1, 7, 9 and 18. Dependent claims 2-6, 8, 11 and 19 also recite patentable subject matter in their own right. Accordingly, withdrawal of the rejection of claims 1-9, 11, 18, 19, 21 and 22 under 35 U.S.C. §102(e) is therefore respectfully requested.

Regarding the rejection of claims 10, 12-17 and 20 under 35 U.S.C. §103(a) as being unpatentable over Miles in view of Underwood, Applicants assert that the Examiner has failed to set forth a proper *prima facie* case of obviousness as set forth in M.P.E.P. §2143.

Three requirements must be met to establish a *prima facie* case of obviousness. First, the cited combination must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Third, there must be some suggestion or motivation to combine reference teachings. While it is sufficient to show that a *prima facie* case of obviousness has not

been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, Applicants assert that even if combined, the Miles and Underwood references, when considered either individually or in combination, fail to teach or suggest all of the limitations of independent claims 12, 16 and 20. For at least this reason, a *prima facie* case of obviousness has not been established.

Independent claim 12 recites a computer-based object control system comprising web servers for storing web pages. The object control system also comprises a main server for communicating with a predetermined web server. The main server permits a specific object to appear in a first specific web page and to be deleted from a second specific web page stored in the specific web server.

Underwood discloses a system for providing an interface between a first server and a second server with a proxy component situated therebetween. The combination of Miles and Underwood fails to disclose a main server that manages the moving of an object. The combination also fails to disclose the movement of an object from one web page to another web page by permitting the object to appear in a first web page and to be deleted from a second web page.

Independent claim 16 recites a computer-based object control system comprising an object to be embedded in a web page stored at a web site on a network. The object control system also comprises an object management means for managing the location of the object on the network. The object management means changes the location of the object on the network in order to move the object across the network. The combination of Miles and Underwood fails to disclose the changing of the location of the object on the network in order to move the object across the network, as described above with regard to claim 1.

Independent claim 20 recites a moving object to be embedded in a web page stored at a web site on a network, which moves from a predetermined web page to another web page. The location on the network is management by specific management means. The combination of Miles and Underwood fails to disclose an object that moves from a predetermined web page to another web page, as described above with regard to claim 1.

Second, with respect to claims 12, 16 and 20, even assuming, *arguendo*, that the Miles and Underwood references can be combined, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Miles and Underwood absent the teachings of the present invention. For at least this reason, a *prima facie* case of obviousness has not been established. Despite the assertion in the Office Action, Applicants do not believe that Miles and Underwood are combinable since it is not clear to one skilled in the art how one would combine them. There is no guidance provided in the Office Action to support such a combination.

Third, there is clear lack of motivation to combine the references. Applicants assert that no motivation or suggestion exists to combine Miles and Underwood in a manner proposed by the Examiner, or to modify their teachings to meet the claim limitations. For at least this reason, a *prima facie* case of obviousness has not been established. Applicants strongly believe that one ordinarily skilled in the art would not look to Underwood's servers interface to modify Miles' Internet scavenger hunt advertising model. That is, the teachings in the references are directed to completely different areas; a first (Miles) toward a method for advertising on the Internet, and a second (Underwood) toward software framework designs. However, other than a very general and conclusory statement in the final Office Action, there is nothing in the two references that reasonably suggests why one would actually combine the teachings of these references.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." *In re Lee*, 277, F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." *Id.* at 1343-1344.

In the Office Action at pages 9-12, the Examiner provides the following statements to prove motivation to combine Miles and Underwood, with emphasis supplied:

It would have been obvious to combine the teachings of Miles and Underwood to facilitate the integration of the database with the main server.

(Pages 9 and 10)

It would have been obvious to combine the teachings of Miles and Underwood to facilitate the integration of the third party advertiser sites with the main server.

(Page 10)

It would have been obvious to combine the teachings of Miles and Underwood to include the use of objects created outside of a web page file, such as embedded pictures.

(Pages 11 and 12)

Applicants submit that these statements are based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

Dependent claims 10, 13-15 and 17 are patentable at least by virtue of their dependency from independent claims 9, 12 and 16. Dependent claims 10, 13-15 and 17 also recite patentable subject matter in their own right. Accordingly, withdrawal of the rejection of claims 10, 12-17 and 20 under 35 U.S.C. §103(a) is therefore respectfully requested.

In view of the above, Applicants believe that claims 1-22 are in condition for allowance, and respectfully request withdrawal of the §101, §102(e) and §103(a) rejections.

Respectfully submitted,



Date: January 5, 2005

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